

The opinion in support of the decision being entered today was not written for publication and is not precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALAN S. AMBROSE, JAMES D. FERGUSON, ROBERT LILIENFELD,
MARK J. MCKINLEY and TIMOTHY MISHLER

Appeal No. 1998-1776
Application No. 08/515,438

ON BRIEF

Before CALVERT, McQUADE, and CRAWFORD, Administrative Patent Judges.

CRAWFORD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 11, 16, 17, 19 through 24, 26 and 27.¹ The appellants have not appealed the rejection of claim 25 (brief at

¹ The examiner finally rejected claims 11, 16, 17, 19, 21 and 22 through 27 under the judicially created doctrine of non-statutory non-obviousness type double patenting as being unpatentable over claims 1 through 7 of U.S. Patent No. 5,458,170. The appellant has offered to file a terminal disclaimer to overcome the rejection. The examiner has not repeated this rejection in the examiner's answer. It is the appellants understanding that claims 16 and 17 have been amended by the examiner to depend from claim 27, however, the examiner has stated that no such examiner's amendment has been made. The examiner's answer does not restate the corresponding 35 U.S.C. § 112, second paragraph, rejection of claims 16, 17, 21 and 22.

page 2). Claims 1 through 10, 12 through 15 and 18 have been canceled.

The appellants' invention relates to a flexible boot for a fuel dispensing nozzle having a sound or video system mounted thereon. An understanding of the invention can be derived from a reading of exemplary claim 11, which appears in the appendix to the appellants' brief.

The prior art

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Kaplan et al. (Kaplan)	5,267,592	Dec. 7, 1993
Koch et al. (Koch)	5,273,087	Dec. 28, 1993

The rejections

Claims 11, 19 and 20 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Koch.

Claims 19, 21 and 22 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Kaplan.

Claims 11, 20, 23 and 24 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kaplan in view of Koch.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 12, mailed December 22, 1997) for the examiner's complete reasoning in support of the rejections, and to the appellants'

brief (Paper No. 11, filed November 4, 1997) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

We turn first to the rejection of claims 11, 19, and 20 as being anticipated under 35 U.S.C. § 102(e) by Koch. It is the examiner's view that Koch discloses:

. . . fuel dispensing nozzle comprising a "housing" 80, a "valve system" 132, a "handle" 141, a "hollow cavity" containing "sound systems" 300, 400 (see col. 12, lines 35-42 and Figures 13 and 14) and a "flexible boot" (see col. 7, lines 5-8) having a "housing" surmounted thereon proximate reference numerals 306 and 308 (see Figure 13). [Examiner's answer at page 5].

We agree with the findings of the examiner and thus, we will sustain this rejection.

In regard to claim 11, appellants argue that Koch does not disclose a flexible boot. We do not agree. Koch at col. 7, lines 5 through 8 clearly discloses a flexible boot.

Appellants also argue, in regard to claims 19 and 20 that Koch does not disclose a fuel dispensing nozzle which itself contains a housing and in which there is situated a wireless sound or video system. These arguments are not persuasive because claim 19 does not recite that the nozzle itself contains a housing in which a wireless sound or video system is situated. Claim 19 recites a "hollow cavity contained within the housing . . . capable of containing a system . . .". The housing in which signaling device 300 is disposed (see Fig. 13) is capable of containing a sound system. In fact, device 300 is disclosed as a device which may produce a visual and audible signal. (Col. 12, lines 36 to 42). Further, neither claim 19 nor claim 20 recites that the sound or video system is wireless.

We turn next to the examiner's rejection of claims 19, 21 and 22 under 35 U.S.C. § 102(e) as being anticipated by Kaplan. The examiner states:

The Kaplan et al. reference discloses a fuel nozzle comprising a "housing" 112 having a "hollow cavity" for housing optional electronics 113 (see col. 3, lines 13-22). All introductory and functional statements of intended use have been carefully considered but are deemed not to impose any structure on the claims distinguishable over the Kaplan et al. device which is further capable of housing a video or sound system if desired. [Examiner's answer at page 5].

We agree with the findings of the examiner and thus we will sustain this rejection.

Appellants argue Kaplan does not describe, disclose or otherwise show a fuel dispensing nozzle in which there is situated a wireless sound or video system. This argument is not persuasive because it is not commensurate with the actual scope of claims 19, 21 and 22 which do not recite that a wireless sound or video system is situated in a fuel dispensing nozzle. Rather, claim 19 from which claim 22 depends, recites that the housing has a hollow cavity which is "capable of containing a system" Claim 21 recites a wired sound or video system. In our view, the housing 112 in Kaplan is capable of containing a video or sound system which is wired or wireless.

We turn finally to the examiner's rejection of claims 11, 20, 23 and 24 under 35 U.S.C. § 103 as being unpatentable over Kaplan in view of Koch. Recognizing that Kaplan does not disclose a flexible boot, the examiner relies on Koch for this teaching and concludes:

. . . it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Kaplan et al. nozzle to have a "flexible boot" in view of the teachings of the Koch et al. reference to provide protection and enhanced appearance for the fuel nozzle (see col. 7, lines 5-8). [Examiner's answer at page 6].

We are in agreement with the conclusion of the examiner with respect to claims 11, 20, and 24 and thus we will sustain this rejection.

Appellants argue, in regard to claim 11, that neither Kaplan nor Koch describes, discloses or otherwise shows or suggests a flexible boot containing a housing which is capable of containing a wireless sound or video system. This argument is not persuasive because it is not commensurate in scope with the actual scope of claim 11 which does not recite a housing capable of containing a wireless sound or video system. In addition, as we stated above, Kaplan discloses a housing or nozzle which is capable of containing a wireless sound or video system. Further, Koch also discloses a housing in a flexible boot which is capable of containing a wireless sound or video system.

Appellants also argue, in regard to claims 19, 20, 21 and 22, that neither Kaplan nor Koch discloses or suggest a housing built into the fuel dispensing nozzle itself. We initially note that this rejection is not directed to claims 19, 21 and 22. Further, we do not find this argument persuasive because it is not commensurate with the actual scope of claim 20 which does not recite a housing built into the fuel dispensing nozzle itself. Rather, claim 19, from which claim 20 depends recites that the hollow cavity contained in the housing is capable of containing a

sound and/or video system. This requirement of claim 19 is met by Kaplan (see Fig. 1 at 113) and Koch (see elements 300 and/or 400 in Figs. 13 and 14).

In regard to claim 24, the appellants argue that neither Kaplan nor Koch discloses a flexible boot for a fuel dispensing nozzle having a housing in which there can be housed a wireless sound or video system. This argument is not persuasive because it is not commensurate in scope with the actual scope of claim 24. Claim 24 recites a housing for containing a system not a housing in combination with a system.

In regard to claim 23, appellants argue that neither Kaplan nor Koch discloses or suggest a flexible boot for a fuel dispensing nozzle having a housing in which there is housed a wireless sound or video system. We agree with the appellants that neither Kaplan nor Koch discloses a wireless sound or video system in the flexible boot of a fuel dispensing nozzle. Therefore, we will not sustain the examiner's rejection as it is directed to claim 23.

In summary,

(1) the examiner's rejection of claims 11, 19, and 20 under 35 U.S.C. § 102(e) as anticipated by Koch is sustained.

(2) the examiner's rejection of claims 19, 21 and 22 under 35 U.S.C. § 102(e) as anticipated by Kaplan is sustained.

(3) the examiner's rejection of claims 11, 20, and 24 under 35 U.S.C. § 103 as being unpatentable over Koch in view of Kaplan is sustained.

(4) the examiner's rejection of claim 23 under 35 U.S.C. § 103 as being unpatentable over Koch in view of Kaplan is not sustained.

REMAND

Finally, we remand this case to the examiner to clarify the rejections detailed in note one, supra.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOHN P. McQUADE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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MURRIEL E. CRAWFORD)	
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